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|-----------------|-------------|----------------------|---------------------|------------------|
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09/686,197

10/10/2000

Carl C. Kah III

P/3426-7 RE

6102

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EXAMINER

HWU, DAVIS D

ART UNIT

PAPER NUMBER

3752

MAIL DATE

DELIVERY MODE

09/08/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/686,197 | <b>Applicant(s)</b><br>KAH, CARL C. |  |
|                              | <b>Examiner</b><br>Davis Hwu         | <b>Art Unit</b><br>3752             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-28,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-28,30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Response to Amendment***

1. Applicant's response of June 15, 2009 have been entered and fully considered.
2. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.
3. After careful reconsideration, the allowance of claims 16-19 and 21 is withdrawn.
4. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
5. Claims 1, 4-11, 20, and 22-28 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

During the prosecution of application 08/405033 (Patent 5,826,797) an amendment was filed August 8, 1996 adding the following limitation to independent claim 1 and including such limitation in independent claim 12: "sealing means surrounding the discharge end of a water passage formed in said nozzle housing; said sealing means including a seal member..." According to Applicant's

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arguments accompanying this amendment, this change occurred to more specifically define the seal of the instant invention from the prior art. Since this limitation was added in response to a rejection of the claims, the removal of such limitation is considered to be recapture.

During the prosecution of application 08/405033 (Patent 5,826,797) an amendment was filed January 15, 1997 adding the following limitation to independent claim 1: "means for retaining said nozzle selection sleeve in place". The next action was a Notice of Allowability. Since this limitation was added in response to a rejection of the claims, the removal of such limitation is considered to be recapture even though that limitation is not specifically mentioned by Applicant or the examiner.

During the prosecution of application 08/405033 (Patent 5,826,797) an amendment was filed August 8, 1996, that added new claims 23-26 that were said to be limited to the combination of the nozzle housing and riser where the nozzle selection is mounted to surround the nozzle housing to rotate therewith and relative thereto. Such combination was deemed to make the claims allowable. New claims 22-30 in this reissue application are deemed to be broader than patented claims 16-19 (which relate to the claims that were numbered 23-26 during the prosecution of application 08/405033) because they do not call for the nozzle selection to surround the nozzle housing and riser. Since this limitation was added in response to a rejection of the claims and deemed to be allowable, the removal of such limitation is considered to be recapture. Also during the prosecution of application 08/405033 (Patent 5,826,797) an amendment and arguments were filed on January 29, 1997 in which the Applicant presented arguments of the examiner's rejection of claim 16, and therefore, any amendment of claim 16 also constitutes recapture.

***Claim Rejections - 35 USC § 103***

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 4-8, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. in view of Meshberg.

Walker et al. discloses a sprinkler comprising: a rotatable housing 90 having a water passage therein; an output shaft 71 mechanically connected to the rotatable nozzle housing for rotating the nozzle housing; a manually adjustable sleeve 116 having an inner surface and a plurality of circumferentially spaced nozzles 118, each of the nozzles having mutually different configurations from each other, the rotatable sleeve being slidably installed around the nozzle housing and being in rotational relationship therewith and thereto so that the rotatable sleeve can be selectively positioned to align one of the nozzles 118 with the discharge end of the water passage for distributing water outwardly from the sprinkler; wherein the nozzle housing 90 has a reduced diameter surface and the inner surface of the rotatable sleeve is in slidable relationship with the reduced diameter surface of the nozzle housing (Fig. 3) as recited in claim 7.

Walker et al. do not disclose the seal as recited. Meshberg teaches a dispensing device comprising a housing 15 having a fluid passage, a manually adjustable sleeve 17 having an inner surface and circumferentially spaced nozzles, and a seal (o-ring) 26 surrounding the discharge end of the fluid passage and dimensioned to continuously bear against the inner surface of the rotatable sleeve 17 (Figure 4) to prevent fluid

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leakage of the fluid. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device of Walker et al. by incorporating a seal as recited to prevent leakages as taught by Meshberg.

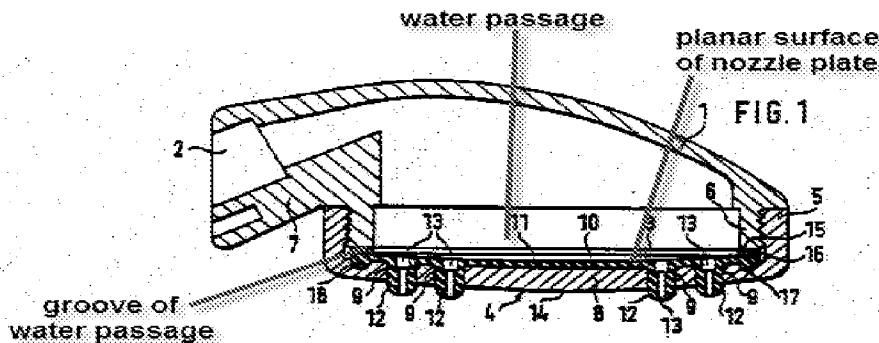
8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. in view of Meshberg as applied to claim 1 above, and further in view of Smith.

Smith teaches a liquid delivery apparatus comprising indicia to identify a selected spray pattern. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device of Walker et al. and Meshberg by indicia to the device to identify a selected spray pattern as taught by Smith.

9. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grassberger in view of Meshberg.

Grassberger discloses a sprinkler comprising a rotatable nozzle housing 1 having a water passage and a central axis about which the housing rotates; a nozzle plate 11 slidably fitting into a groove formed into the water passage in the nozzle housing 1 and having a planar surface (see Fig. 1) below, wherein the nozzle plate is accessible so as to be removable by removing device 4 from the housing in which the removal process can take place while the sprinkler is operational.

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Meshberg teaches a dispensing device comprising a housing 15 having a fluid passage, a manually adjustable sleeve 17 having an inner surface and circumferentially spaced nozzles, and a seal (o-ring) 26 surrounding the discharge end of the fluid passage and dimensioned to continuously bear against the inner surface of the rotatable sleeve 17 (Figure 4) to prevent fluid leakage of the fluid. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device of Grassberger by incorporating a seal member to surround the water passage and being dimensioned to continuously bear against the planar surface to prevent leakages as taught by Meshberg. Forming a tapered recess as recited in claim 14 would have been a matter of design choice since the seal will still seat properly to prevent leakages with such a modification.

10. Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. in view of Meshberg.

Walker et al. discloses a sprinkler comprising: a rotatable housing 90 having a water passage therein; a nozzle plate (the combination of sleeve 116 and its flat top portion),

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at least one orifice 118 disposed in the nozzle plate to be aligned with the water passage as recited, the nozzle plate fitting into the water passage and having a planar surface; and a riser as recited in claim 15. Providing a groove in the water passage for the nozzle plate would have been a matter of design choice since the nozzle plate will still sit properly in the water passage with such a modification. Walker et al. also discloses a cap 24 which can be removed for convenient service or maintenance access to various parts of the sprinkler and the plate can be removed while the sprinkler is operational if necessary. Meshberg teaches a dispensing device comprising a housing 15 having a fluid passage, a manually adjustable sleeve 17 having an inner surface and circumferentially spaced nozzles, and a seal (o-ring) 26 surrounding the discharge end of the fluid passage and dimensioned to continuously bear against the inner surface of the rotatable sleeve 17 (Figure 4) to prevent fluid leakage of the fluid. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device of Walker et al. by incorporating a seal as recited to prevent leakages as taught by Meshberg.

11. Claims 22, 25, and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al.

Walker et al. do not disclose a groove as recited in claim 22, however, providing a groove in the water passage for the nozzle plate would have been a matter of design choice since the nozzle plate will still sit properly in the water passage with such a modification. Walker et al. also discloses the ability to access various parts of the sprinkler, and it would have been obvious to one having ordinary skill in the art at the

time the invention was made that the nozzle sleeve would dismountable and exchangeable and could be done so while the sprinkler is operational as recited in claim 26.

***Claim Rejections - 35 USC § 102***

12. The text of those sections of 12.Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 20, 21, 23, 24, 27, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al.

Walker et al. shows a sprinkler comprising: a riser assembly; a rotatable nozzle housing 90 having a flow passage formed therein; a drive shaft 71 for rotating the nozzle housing as recited; and at least one selectable nozzle arrangement 116 for aligning one of a plurality of nozzles orifices 118 with the flow passage as recited, wherein the nozzle orifices are each configured mutually differently to provide different flow characteristics, and wherein a selected one of the nozzle orifices to be aligned with the flow passage can be changed while the sprinkler is operational. The nozzle arrangement 116 has a flat top portion and the combination of 116 and its flat top portion forms a nozzle plate as recited in claim 21.

14. Claims 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Kah, Jr.

Kay, Jr. shows a sprinkler comprising a riser assembly a rotatable nozzle housing having a flow passage formed therein a drive shaft 104 as recited, and a nozzle plate 196 including an orifice as recited.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Davis D. Hwu whose telephone number is 571-272-4904. The examiner can normally be reached on 8:00-4:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Len Tran can be reached on 571-272-1184. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

/Davis D Hwu/  
Primary Examiner, Art Unit 3752